



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,224	06/22/2000	Jorma Jaakkola	# 2132-34PCON	7789

7590

09/09/2003

Lance J. Lieberman, Esq.  
Cohen Pontani Lieberman & Pavane  
Suite 1210  
551 Fifth Avenue  
New York, NY 10176

EXAMINER

ORTIZ, XIOMARA Y

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 09/09/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/599,224

Applicant(s)

JAAKKOLA ET AL.

Examiner

Xiomara Y. Ortiz

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

1. The disclosure is objected to because of the following informalities: The specifications make reference to figure 1 but mention parts that appear in figure 2 (see page 7 lines 5-7, mentioning GSM network and HRL, also in page 7 line 17 PSTN, etc.).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: SSP/IP and LAN. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 1 and 8 are objected to because of the following informalities: Appropriate correction is required. In claim 1 line 13 and in claim 8 line 9, the words "one of between" does not specify the way of exchange of subscriber data. For the purpose of analyzing the case, it is

assumed that the exchange of subscriber data is between the telecommunication network elements of the first and the second networks handling subscriber data or between the telecommunication network elements handling subscriber data and the subscriber database.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-4,6-11 are rejected under 35 U.S.C. 102(e) as being anticipated by David Buckley, U.S. Patent No.6163809.

Regarding claim 1 and 8, Buckley discloses an invention directed to system and methods that comprise means for receiving a message from a first network and for providing the received message to a second network, as mention in column 9 line 38, where the status notification

information may be transferred with the message within the network in a matter transparent to the network (see col. 3 lines 60-64). Buckley also shows means for storing data in a data store that may be a database (see col. 12 lines 53-56), and means of allowing a message to transit or exchange of a foreign network and return to the original network (see col. 13 lines 57-63).

Regarding claim 2 and 9, Buckley further disclosures means for transmission of signaling from one network to another, (see col. 2 lines 39-42).

Regarding claim 3,4,10 and 11, Buckley further discloses means of translations of information from a format supported by the originating network into a format supported by the destination network (see col. 3 lines 23-26).

Regarding claim 6, Buckley further discloses that an element of a local network contains an Internet mail service or other mail connector, a store, and a message transfer agent (col. 9 lines 3-4).

Regarding claim 7, Buckley further discloses that an exemplary system for implementing the invention includes a general purpose computing device (col. 6 lines 17-19), that includes a keyboard and pointing devices to enter commands and information, a monitor or other type of display device, and a video adapter (see col. 6 lines 58-60, 66-67, and col.7 line 1).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over David Buckley, U.S. Patent No.6163809 in view of Vasanthan S. Dasan, U.S. Patent No. 5761662.

Regarding claim 5 and 12, Buckley discloses all the limitation on claims 1 and 8. Buckley fails to disclose a means of forming a service profile for a subscriber of one of the networks. However Dasan discloses an automatic method and system for retrieving information bases on a user-defined profile (see col. 2 lines 3-5).

Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Buckley's invention to form a service profile for a subscriber.

One of ordinary skill in the art would have been motivated to do this combination in order to retrieve a subset of the information from a database based upon which information is of interest to the user, or the like, as specified in the user-defined profile (see col.2 lines 13-17).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to subscriber data handling in telecommunication networks:

a. U.S. Pat. No. 55828959 to Lauri Söderbacka, which discloses telecommunication networks comprising exchanges, subscriber stations, at least part capable of moving in the network, and at least one subscriber database maintaining location information of subscribers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xiomara Y. Ortiz whose telephone number is (703) 305-6783. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Xiomara Y. Ortiz  
Patent Examiner  
Art Unit 2141



**RUPAL DHARIA**  
SUPERVISORY PATENT EXAMINER